

## **REMARKS / ARGUMENTS**

Claims 9 and 16-22 are withdrawn pursuant to the restriction requirement imposed by examiner. Claim 13 is amended to depend from claim 12, thereby overcoming the rejection of claim 13 under 35 U.S.C. 112, second paragraph. Claim 26 is canceled and its subject matter is incorporated into claim 23. Claims 23-25 and 27-28 are also amended to better differentiate between a "beverage container" as disclosed by U.S. 3,556,341 to Rains and a "holder for a beverage container" as disclosed by Applicant. The amendments to claims 23-25 and 27-28 are fully supported by the specification as originally filed such as, for example, in paragraphs 1, 12, 13 and 18 of the specification and by FIGS. 1-4 and 6 of Group 1 as determined by examiner.

Claims 23 and 25 are rejected under 35 U.S.C. 102 (b) as anticipated by Rains. Applicant respectfully traverses this rejection as applied to claims 23 and 25 as amended herein and requests that it be reconsidered and withdrawn. Rains discloses a drinking container having the general configuration of a cup with magnets adhesively attached to the outside of the side and bottom walls. As amended, claim 23 recites a holder for a beverage container having a side wall further comprising an outer shell and an inner shell, with a magnet disposed between the outer shell and inner shell. Claim 25, which depends from claim 23, now likewise recites that structure, which is not disclosed by Rains.

Claims 1-6 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rains in view of U.S. 6,390,319 to Yu. Applicant traverses the rejection. The combination Yu with Rain does not establish a *prima facie* case of obviousness. Rain discloses a beverage container attachable to a ferrous surface. Yu discloses beverage containers and holders designed to impart therapeutic, purifying and preservative benefits to the grasping hand of the user or to a beverage surrounded by a ring magnet or a circumferentially disposed array of magnets establishing a magnetic field around

the perimeter of the container or beverage holder. There is no disclosure in either patent that would lead one of skill in the art to even attempt to combine the teachings of Yu with those of Rain. Only by the exercise of legally impermissible hindsight reconstruction can one make that argument, and even then, the logic fails.

It is illogical that one trying to improve upon the beverage cup of Rains would look to a reference such as Yu. Rain teaches exerting a magnetic force outwardly from the outside surface to provide strong magnetic attachment to an adjacent ferrous metal surface. Conversely, Yu teaches the importance of exerting a magnetic field inwardly around the entire perimeter of a beverage container so as to establish a magnetic field throughout the beverage surrounded by the magnet. Yu discloses devices incapable of holding or supporting a beverage on a vertical ferrous surface because they would fall, roll, or slide.

Beyond the legally impermissible combination of the Rain and Yu references, their combined disclosures still do not teach applicant's claimed invention. Each of claims 1-6 recites a thermally insulative beverage holder wherein one portion of the side wall further comprises inner and outer side wall sections having a magnet with a substantially flat, outwardly facing surface disposed between the inner and outer side wall sections. Rain does not disclose the recited structure; neither does Yu. One following the teachings of Rain who wanted to better control heat transfer through the side wall of rain would simply make Rain's side wall of a thermally insulative material and then glue magnets on the outside, instead of imbedding the magnet inside the wall as disclosed in relation to FIG. 3 of Yu, who was trying to reduce the distance from the magnet to the contained liquid so as to maximize the magnetic field exerted inwardly toward the contained beverage. The limitations of the other dependent claims, when taken in combination with the elements of claim 1 as discussed above, likewise recite beverage holders that are distinguishable over Rains and Yu.

Claims 1, 7, 10-15, 23, 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Rains. Applicant also traverses this ground of rejection both on the basis of the legally insupportable combination of the two references and because the two references, even if combined, do not render Applicant's claimed invention obvious. Each of the rejected claims recites a structure in which the holding magnet is disposed in a portion of the side wall between inside and outside wall sections or shells. Neither Yu nor Rain discloses that structure. One of skill in the art trying to make a beverage holder that will stick to walls would not look to Yu in the first instance for guidance on how to do that. Yu is a patent that teaches how to impart therapeutic, purifying and preservative benefits to beverages by establishing a magnetic field inside the beverage. Assuming, however, for sake of argument that one did combine Rain with Yu, it is more likely that he would simply have attached more magnets to one side of the outside wall of the beverage holder disclosed in FIG. 3 of Yu in an effort to maximize the magnetic force being exerted outwardly against the wall.

Examiner also summarily dismisses the recitations of "insert molded" and "dip molded" in claims 10 and 11, respectively, as having no material effect on the structure. Applicant respectfully disagrees. Also, Yu does not provide an enabling disclosure as to how his invention is made, other than to state "encased within" (col. 3, line 44) or a "groove or other accommodation formed in a foam rubber cylinder" (col. 3, lines 45-46). Rain contributes nothing on that point, because he simply teaches using an adhesive to attach his magnets to the outside surface.

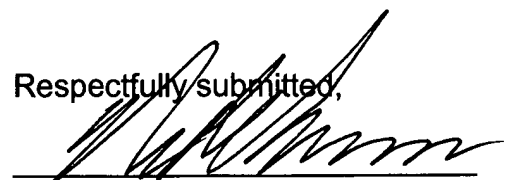
Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Rains and further in view of U.S. 5,699,631 to Tyson. Applicant respectfully traverses the rejection. Tyson discloses a rotatable magnetic memory reminder device, and is even further removed from Applicant's invention. Tyson does not disclose the use of Applicant's preferred magnet, uses his magnet for a completely different purpose, and, unlike Applicant, leaves his magnets exposed. For mounting purposes,

Tyson discloses the use of a pair of suction cups (col. 3, line 10). It is again legally insupportable and illogical that the invention of claim 8, which depends from claim 1 and incorporates all its recitations as well, is rendered obvious by the combination of Tyson with Yu and Rains. Finally, examiner suggests that Tyson's magnets are good because they are flexible as taught by Yu. Nowhere does Applicant teach that flexible magnets are either desirable or efficacious for use in his invention.

In paragraph 19 of the specification, Applicant *teaches* what is important about the magnets used in his invention and what properties, characteristics and dimensions are particularly preferred. Those recitations are carried forward into many of the rejected claims. Rather than acknowledging the completeness of his description and his contribution to the art, examiner asserts, for example, in paragraphs 13 and 14 of the instant Office Action that "Applicant has not disclosed that his shape and size requirement solves any stated problem or is for any particular purpose" and is, instead, "a design choice." On the contrary, it is Rains and Yu and Tyson who have failed to teach what magnets successfully achieve the desired objectives (as stated, for example, in great detail at paragraph 19, lines 8-14 of the specification) in Applicant's invention.

Applicant accordingly requests that the instant rejections be reconsidered and withdrawn. Please charge any additional fee that may be required or credit any overpayment to Deposit Account No. 12-1781 of Locke Liddell & Sapp, LLP.

Respectfully submitted,



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